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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,945	09/12/2000	Franciscus L.A.J. Kamperman	PHN 17,285	2098

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Philips Electronics North American Corp.  
580 White Plains Rd.  
Tarrytown, NY 10591

EXAMINER
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KIM, JUNG W

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/623,945	Applicant(s) KAMPERMAN ET AL.	
	Examiner Jung W Kim	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

### **DETAILED ACTION**

1. Claims 1-4 and 10-29 have been examined. Applicant in the amendment filed on October 22, 2005 amended claims 1, 3 and 13 and added new claims 25-29. Claims 5-9 were canceled in a previous amendment.

#### ***Response to Amendment***

2. The objection to the specification is withdrawn as the amendments to the disclosure overcome the objections.
3. The objection to claim 20 is withdrawn as the amendment to claim 20 overcomes the objection.
4. The 112, second paragraph rejection to claims 3 and 13 are withdrawn as the amendments to the claims overcome the 112, second paragraph rejections.

#### ***Response to Arguments***

5. The following is a response to applicant's arguments on pgs. 6-10 in the amendment filed on October 22, 2005.
6. Regarding applicant's argument that "[c]laims 10-13 are directed to a computer-readable medium having a program stored within", and hence the 101 rejection is not proper (see Remarks, pg. 7, 1<sup>st</sup> paragraph), examiner disagrees. Claims 10 and 11 are drawn to signals per se. The preamble of claims 10 and 12, "A signal comprising ...",

distinctly identifies the invention as being drawn to signals, and hence, is non-statutory as not being tangibly embodied in a manner so as to be executable and is non-statutory for failing to be in one of the categories of invention. Claims 10-13 are drawn to encoded data which is nonfunctional descriptive material, not a process, machine, manufacture, nor composition of matter. The preamble of claims 10 and 12, "A signal comprising encoded data ..." and the preamble of claim 11, "A data carrier comprising a recorded signal ..." and the preamble of claim 13, "A data carrier comprising the encoded signal ..." distinctly identifies the invention as being drawn to nonfunctional descriptive material, and hence, is non-statutory for failing to be in one of the categories of invention.

7. Regarding applicant's argument Linnartz does not cover the limitations of claim 3, specifically that "[t]here is no disclosure or suggestion within Linnartz for reducing the data rate" and "there is no teaching or suggestion within Linnartz for using encoded data to derive the parameter set and the data-rate-reduced signal" (see Remarks, pg. 7, 4<sup>th</sup> paragraph), examiner disagrees. MPEG compression, specifically Inter-frame encoding of data frames to P and B frames, are standard means of reducing the encoded bit rate; Linnartz teaches compression techniques using Intra-frame (I frames) and Inter-frame coding (P and B frames). See Linnartz, pg. 2, lines 9-12. Further, Linnartz teaches compressed audio or video signals comprise a plurality of coding parameters (these values indicate how an encoded stream is encoded for proper decoding). See Linnartz, pg. 1, lines 27-28. Linnartz discloses setting a predetermined value of one of these parameters (number of slices) to insert a watermark, wherein the assignment of the

predetermined value of the one of the parameters affects the other parameters. See Linnartz, pg. 1, lines 23-26; pg. 3, lines 18-20.

8. Regarding applicant's argument that Linnartz does not cover the limitations of claim 4, specifically that "Linnartz teaches the extraction of the parameter set from the encoded signal rather than extracting information from the parameter set from the encoded signal rather than extracting information from the parameter set as defined by claim 4", examiner notes that decoding of MPEG compressed values necessarily requires extracting information from the parameter set of encoded data. See Linnartz, pg. 3, lines 5-6.

9. Finally, applicant's arguments of claims 1, 2 and 5-28 are based on the arguments against the rejections of claims 1 and 4. Hence, the prior art of record cover applicant's claimed invention.

### ***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-13 are rejected under 35 U.S.C. 101 because claims 10 and 12 are drawn to signals per se, not embodied on a computer-readable medium nor on an electromagnetic wave. See MPEP 2106 IV B. 1(a) and (c); *In re Warmerdam*, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994); and *O'Reilly v. Morse*, 56 U.S. 62, 112-114 (1853). In addition, claims 10-13 are drawn to encoded data which is nonfunctional descriptive material, not a process, machine, manufacture, nor composition of matter.

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See MPEP 2106 IV B. 1(b) and *In re Warmerdam*, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 1, 3, 4, 10-14, 16, 17, 19-21, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Linnartz PCT International Application Number PCT/IB96/00992 (hereinafter Linnartz).

13. As per claim 1, Linnartz discloses a method of encoding data, comprising embedding supplemental data by inserting the supplemental data into the data using at least one parameter which is altered in order to embed the supplemental data; and deriving the supplemental data from other data. See Linnartz, pg. 1, line 22-pg. 2, line 23; pg. 3, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, especially lines 6-9 and 18-20.

14. As per claim 3, Linnartz discloses a method of encoding input data (see Linnartz, page 1, lines 23-25), comprising the steps of:

- a. partitioning the data into frames (see Linnartz, page 2, lines 10-12; page 3, lines 6-10);
- b. determining a set of parameters for each frame (see Linnartz, page 1, lines 27-28; page 2, lines 9-12);
- c. reducing the data rate of the input signal by applying an algorithm which is controlled by the parameter set whereby encoded data includes the set of parameters or at least data which can be used to derive the parameter set and the data rate-reduced signal (see Linnartz, page 1, lines 27-28); and
- d. embedding supplemental data into encoded data, the parameter set is affected by the supplemental data (see Linnartz, page 3, lines 11-20).

The aforementioned covers claim 3.

15. As per claim 4, Linnartz discloses a method as outlined above in the claim 3 rejection under 35 U.S.C. 102(b). In addition, the method includes a method of extracting information which is embedded in the parameter set of an encoded signal as defined in claim 3 (see Linnartz, page 1, lines 23-26; page 3, line 21-page 4, line 2).

16. As per claims 10 and 12, Linnartz discloses a method as outlined above in the claim 1 and 3 rejections. In addition, the encoded data is a signal (see Linnartz, page 1, line 6).

17. As per claim 11, Linnartz discloses a method as outlined above in the claim 10 rejection. In addition, a data carrier comprises the recorded signal (see Linnartz, page 5, line 17).

18. As per claim 13, Linnartz discloses a method as outlined above in the claim 12 rejection. In addition, a data carrier comprises an encoded signal (see Linnartz, pg. 5, line 17).

19. As per claims 14, 16 and 17, Linnartz discloses a method as outlined above in the claim 1, 3 and 4 rejections. In addition, the method consists of an arrangement (see Linnartz, Figures 1, 2, and 4).

20. As per claims 19-21, 23 and 24, Linnartz discloses a method as outlined above in the claim 1, 3, 4, 14, 16 and 17 rejections. In addition, the arrangement for performing the method is a disc player for audio and audio-visual media (see Linnartz, page 5, lines 4-24).

21. Claims 1, 2, 15 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Isnardi et al. U.S. Patent No. 6,037,984 (hereinafter Isnardi).



22. As per claim 1, Isnardi discloses a method of encoding data, comprising embedding supplemental data by inserting the supplemental data into the data using at least one parameter which is altered in order to embed the supplemental data; and deriving the supplemental data from other data (see Isnardi, col. 2:15-31; 3:45-col. 4:50). The aforementioned cover the limitations of claim 1.

23. As per claim 2, Isnardi discloses a method as outlined above in the claim 1 rejection. In addition, Isnardi discloses a method of extracting supplemental data of encoded data. See Isnardi, col. 4:45-46.

24. As per claim 15, Isnardi discloses a method as outlined above in the claim 2 rejection. In addition, the method consists of an arrangement (see Isnardi, Figure 1).

25. As per claim 25, Isnardi discloses a method as outlined above in the claim 1 rejection. In addition, Isnardi discloses a method of encoding supplemental data of encoded data, wherein lossless encoding is used to encode the supplemental data. See, Isnardi, col. 4:38-40.

26. As per claim 26, Isnardi discloses a method as outlined above in the claim 1 rejection. In addition, Isnardi discloses a method of encoding supplemental data of encoded data, wherein the supplemental data is encoded bit by bit. See Isnardi, col. 4:38-40.

27. As per claim 27, Isnardi discloses a method as outlined above in the claim 1 rejection. In addition, Isnardi discloses a method of encoding supplemental data of encoded data, wherein before the embedding, partitioning of the data into frames and determining a set of parameters for each frame, wherein the set of parameters can be altered to embed the supplemental data. See Isnardi, col. 2:27-31, 64-65; 3:50-54, especially lines 50-51; 4:20-34, 38-40.

28. As per claim 28, Isnardi discloses a method as outlined above in the claim 27 rejection. In addition, Isnardi discloses a method of encoding supplemental data of encoded data, wherein encoded data is used to derive the set of parameters. See Isnardi, col. 4:31-34, 38-40.

29. As per claim 29, Isnardi discloses a method as outlined above in the claim 1 rejection. In addition, Isnardi discloses a method of encoding supplemental data of encoded data, wherein the parameters is altered to a dedicated value in response to the supplemental data to be embedded. See Isnardi, col. 4:20-34, 38-40.

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isnardi in view of Moskowitz et al. U.S. Patent No. 5,889,868 (hereinafter Moskowitz).

32. As per claims 18 and 22, Isnardi discloses a method as outlined above in the claim 2 and 15 rejections. Isnardi does not disclose a playback device, specifically a disc player for audio and audio-visual media with an arrangement to extract supplemental data. Moskowitz teaches combining watermarking schemes having the arrangement to extract supplemental data from encoded data with a disc player for audio and audio-visual media (see Moskowitz, col. 1:60-67; 10:30-62, especially line 60; 17:60-18:4). It would be obvious to one of ordinary skill in the art at the time the invention was made for the arrangement defined in claim 2 to be combined in a disc player. Motivation to combine enables the arrangement to be incorporated into nongeneralized computing devices that play or record copyrighted content. See Moskowitz, col. 10, lines 58-62. The aforementioned cover the limitations of claim 18 and 22.

### ***Conclusion***

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

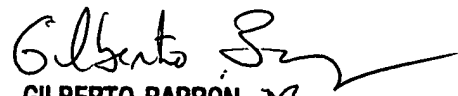
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim  
Examiner  
Art Unit 2132

Jk  
February 3, 2005



GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100